

REMARKS

Paragraph [0007] has been amended to correctly recite the U.S. Patent No. 6,136,668 whose number had inadvertently been entered incorrectly.

The Office Action mailed September 20, 2005, has been received and reviewed. Claims 1-77 are currently pending in the application, of which claims 1-24 are currently under examination. Claims 25-77 are withdrawn from consideration as being drawn to a non-elected invention and have been canceled. Claims 1-12, 14, 15, 18-22 and 24 stand rejected. Claims 13, 16, 17 and 23 have been objected to as being dependent upon rejected base claims, but the indication of allowable subject matter in such claims is noted with appreciation. Applicant has amended claim 1, incorporating the limitation of claim 17 that has been canceled herein; added claims 78-86, with new independent claims 78, 82, and 86 incorporating the subject matter previously indicated as allowable in claims 13, 16, and 23; and respectfully requests reconsideration of the application as amended herein.

35 U.S.C. § 102 Anticipation Rejections

Anticipation Rejection Based on U.S. Patent No. 6,399,463 B1 to Glenn, et al.

Claims 1, 2, 4, 8 and 18 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Glenn, et al., U.S. Patent No. 6,399,463 B1 (hereinafter "Glenn"). Applicant respectfully traverses this rejection, as hereinafter set forth.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Brothers v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Claim 1 has been amended to include the limitation from claim 17, specifically that of "cutting from the active surface of the semiconductor wafer body through the semiconductor wafer body with at least one laser beam along the plurality of streets between the active surface of the semiconductor wafer body and the at least one trench." As the examiner graciously noted

in the Office Action of Sept. 20, 2005, the prior art neither teaches nor suggests this limitation. Therefore, the withdrawal of the 35 U.S.C. § 102(b) rejection is respectfully requested.

The withdrawal of the 35 U.S.C. § 102(b) rejection of claims 2, 4, 8, and 18 is respectfully requested because each of the claims depends either directly or indirectly from allowable independent claim 1.

35 U.S.C. § 103(a) Obviousness Rejections

Obviousness Rejection Based on U.S. Patent No. 6,399,463 B1 to Glenn, *et al.*, in view of U.S. Patent No. 6,420,245 B1 to Manor

Claims 7, 9, 12, 14, 15, 19-22 and 24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Glenn in view of Manor, U.S. Patent No. 6,420,245 B1 (hereinafter “Manor”). Applicant respectfully traverses this rejection, as hereinafter set forth.

M.P.E.P. 706.02(j) sets forth the standard for a Section 103(a) rejection:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, **the prior art reference (or references when combined) must teach or suggest all the claim limitations.** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). (Emphasis added).

Claim 1 has been amended to include the limitation from claim 17, specifically that of “cutting from the active surface of the semiconductor wafer body through the semiconductor wafer body with at least one laser beam along the plurality of streets between the active surface of the semiconductor wafer body and the at least one trench.” As the examiner graciously noted in the Office Action of Sept. 20, 2005, the prior art neither teaches nor suggests this limitation.

Because independent claim 1 is allowable, the withdrawal of the 35 U.S.C. § 103(a) rejection of claims 7, 9, 12, 14, 15, 19-22 and 24, each depending either directly or indirectly from allowable independent claim 1, is respectfully requested.

Obviousness Rejection Based on U.S. Patent No. 6,399,463 B1 to Glenn, *et al.*, in view of U.S. Patent No. 6,444,499 B1 to Swiss, *et al.*

Claim 3 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Glenn in view of Swiss, *et al.*, U.S. Patent No. 6,444,499 B1 (hereinafter “Swiss”). Applicant respectfully traverses this rejection, as hereinafter set forth.

As discussed above, Claim 1 has been amended to include the limitation from claim 17. Therefore, because independent claim 1 is allowable, the withdrawal of the 35 U.S.C. § 103(a) rejection of claim 3 that depends indirectly from allowable independent claim 1 is respectfully requested.

Obviousness Rejection Based on U.S. Patent No. 6,399,463 B1 to Glenn, *et al.*, in view of U.S. Patent Publication No. 2005/0082651 A1 to Farnworth, *et al.*

Claims 5 and 6 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Glenn in view of Farnworth, *et al.*, U.S. Patent Publication No. 2005/0082651 A1 (hereinafter “Farnworth”). Applicant respectfully traverses this rejection, as hereinafter set forth.

As discussed above, Claim 1 has been amended to include the limitation from claim 17. Therefore, because independent claim 1 is allowable, the withdrawal of the 35 U.S.C. § 103(a) rejection of claims 5 and 6, each depending either directly or indirectly from allowable independent claim 1, is respectfully requested.

Obviousness Rejection Based on U.S. Patent No. 6,399,463 B1 to Glenn, *et al.*, in view of U.S. Patent No. 6,420,245 B1 to Manor as applied to claim 9 above, and further in view of U.S. Patent Publication No. 2005/0082651 A1 to Farnworth, *et al.*

Claims 10 and 11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Glenn in view of Manor as applied to claim 9 above, and further in view of Farnworth. Applicant respectfully traverses this rejection, as hereinafter set forth.

As discussed above, Claim 1 has been amended to include the limitation from claim 17. Therefore, because independent claim 1 is allowable, the withdrawal of the 35 U.S.C. § 103(a) rejection of claims 10 and 11, each depending either directly or indirectly from allowable

independent claim 1, is respectfully requested.

Objections to Claims/Allowable Subject Matter

Claims 13, 16, 17 and 23 stand objected to as being dependent upon rejected base claims, but are indicated to contain allowable subject matter and would be allowable if placed in appropriate independent form. The examiner's indication of allowable subject matter is appreciably noted.

ENTRY OF AMENDMENTS

The amendment to claim 1 above and the addition of new claims 78-86 should be entered by the Examiner because the amendment is supported by the as-filed specification and drawings and do not add any new matter to the application. Further, the amendments do not raise new issues or require a further search.

CONCLUSION

Claims 1-24 and 78-86 are believed to be in condition for allowance, and an early notice thereof is respectfully solicited. Should the Examiner determine that additional issues remain which might be resolved by a telephone conference, he is respectfully invited to contact Applicant's undersigned attorney.

Serial No. 10/797,504

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'CB', with a long horizontal flourish extending to the right.

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Date: December 20, 2005

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